

Appln. No. 09/921,856
Amdt. dated Aug. 4, 2005
Reply to Final Office Action of May 4, 2005
Docket No. BOC9-2000-0082 (217)

REMARKS/ARGUMENTS

These remarks are made in response to the final Office Action of May 4, 2005 (Office Action). As this response has been timely filed within the 3-month shortened statutory period, no fee is believed due.

Applicants, as an initial matter, wish to thank the Examiner for correctly noting at Page 2 of the Office Action that the application is eligible for continued examination under 37 C.F.R. § 1.114 and for having entered Applicants' amendment of August 6, 2004.

At page 2 of the Office Action, Claims 1-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2002/0023230 to Bolnick, *et al.* (hereinafter Bolnick) in view of U.S. Published Application No. 2002/0016857 to Harari (hereinafter Harari), and further in view of U.S. Published Application No. 2002/0098849 to Bloebaum *et al.* (hereinafter Bloebaum).

I. Applicants' Invention

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. Applicants' invention is directed to a method, system, and apparatus for identifying common contacts through which people can establish relationships. Applicants' invention facilitates establishment of these relationships by identifying and listing contacts, such as social and/or business contacts, that are shared by the parties even though the parties themselves may be initially unaware of any specific contacts that they have in common.

In one embodiment, contact lists of different users can be compared with one another to determine whether the users associated with the contact lists have any acquaintances or contacts in common with one another. In another embodiment, mutual contacts of different users can be identified despite the fact that such mutual contacts are known through several "degrees of separation." Accordingly, Applicants' invention can analyze at least two unique contact lists, each of which corresponds to a different user. The lists of contacts specified in one or more of the "original" contact lists can be retrieved and then compared with one or more contact lists associated with yet another party. In this manner, multiple contact lists can be processed to

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determine whether two parties are connected through, or know, "friends of friends." Indeed, the process optionally can extend through additional layers of contacts so that relationships can be established through "friends of friends of friends" and so on. (See, e.g., Specification, p. 8, lines 8-15.)

II. Claims 1-3, And 12-14 Define Over Bolnick, Harari And Bloebaum

Claim 1 is directed to a computerized method for generating a list of common contacts. The method includes first retrieving a plurality of contacts from an exposed, remotely accessible contact list that defines a first set associated with a user; first comparing the first retrieved contacts to stored contacts in a locally accessible contact list defining a second set associated with a different user, the first and second sets being distinct from one another; and first identifying common contacts among the first compared contacts.

The method further includes a second retrieving of a plurality of contacts from an exposed, remotely accessible contact list associated with one of the first retrieved contacts; a second comparing of the second retrieved contacts to the locally stored contacts; and a second identifying common contacts among the second compared contacts.

Still further, the method includes generating and storing a common contacts list containing the identified common contacts. The common contacts list defines yet another distinct set.

Each of the steps recited in Claim 1 is now examined individually. The steps are examined here in the order and grouping that each is addressed in the Office Action.

first retrieving a plurality of contacts from an exposed, remotely accessible contact list, the exposed, remotely accessible contact list defining a first set associated with a user

It is asserted at page 2 of the Office Action that Bolnick discloses an identical first retrieving step. Paragraphs 0026-0027 and 0170-0171 are cited in support of the assertion.

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Bolnick is directed to a system and method for "providing a secure data channel between a user and associates" by which "pushed information from one or more associates" can be received from and conveyed to the user. (Para. 0025; Abstract). The "pushed information" is "user profile information, family definitions, and/or a hardware signature." Accordingly, as described throughout the reference, Bolnick is directed to providing a single, albeit updatable and secure, source of information accessible to multiple users or "associates."

Bolnick does not teach or suggest retrieving a contact list associated with a user for the sake of comparing contacts culled from the contact list with contacts culled from a different contact list associated with a different user. Bolnick addresses not the retrieval of contacts for the sake of comparing contact lists, but rather for the conveying of information shared by multiple users:

"[0026] In an exemplary embodiment of the invention, the conveyance step can convey information to the user using, e.g., a web interface, an interactive voice response (IVR) system, a wireless access device, a communications device, an interactive television (TV) device, a palm top computing device, a synchronized device, a personal digital assistant, a computing device or another device having a direct and/or indirect access to the Internet.

"[0027] In an exemplary embodiment of the invention, the method can further include sharing access to the personal information to an individual user or a family. In an exemplary embodiment, the family can include another user [or] multiple related users."

The plain language of the reference explicitly demonstrates that Bolnick is not concerned with the retrieval of any information for the sake of comparing the information to different information. Instead, Bolnick is directed to the conveying of shared information. Bolnick does not retrieve information, but instead receives information – that is, "pushed information" – so that the information can be conveyed over "a secure channel" to a user who shares access to the information with other "associates."

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Regardless of whether conveying can legitimately be said to be the mirror image of retrieving, the difference between Bolnick and Applicants' invention is more than a matter of semantics. Without an explicit retrieval of one set of information – contacts retrieved from a remotely accessible contact list – there simply can be no comparison of contacts culled from different contact lists, according to the next step recited in Claim 1.

first comparing said first retrieved contacts to stored contacts in a locally accessible contact list, said locally accessible contact list defining a second set distinct from said first set and associated with a different user

It is asserted at page 3 of the Office Action that Bolnick discloses an identical step. Paragraphs 0065-0066 and 0162-0167 of Bolnick are cited in support of the assertion.

Bolnick nowhere describes a contact list associated with one user and a separate, different contact list associated with another user. Even if by happenstance the different contact lists comprise the same contacts, each is associated with a different user. As already pointed out, however, Bolnick is explicitly concerned with providing shared access to the same set of personal, familial, and associated information. In Bolnick, different contact lists are not associated with different users. Instead, different users share access to the same shared information. This is clear from the portions of the reference cited in the Office Action:

"[0163] The Your Families section allows groups of people to define themselves as a family and share selective information with one another."

"[0164] Each family can share selective portions of an up-to-date calendar, address/phone book, and to-do list, and can have the ability to send announcements, memos, postcards, letters on stationary, one-page newsletters, and notices of items for sale/trade/free."

The object of Bolnick is not to make comparisons, but to provide the convenience of sharing specific information common to each member of the family or other association of users. The

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shared information can be updated, but ultimately, Bolnick remains a single, albeit updatable, source of common information to which multiple members share access:

"[0167] The days of out-of-date contact information are history for site [singular] users [plural] since a change in a shared phone listing can be seen by all members who are linked to that phone listing [commonly shared]. That is, when a user moves down the street, all the user's "families" (e.g., relatives, clubs, and organizations) and associations . . . with whom that information was shared can automatically be updated."

Paragraphs 0068-0070 and 0167-0171, also cited at Page 3 of the Office Action, further undercut any inference that Bolnick teaches or suggests the retrieving of contacts from one contact list associated with a user for the purpose of comparing the contacts with those from a distinct contact list associated with a different user. Bolnick, again, is concerned with providing secure access to user-supplied and user-updated information:

"[0169] In essence, defined associations can replace defined families. A difference is that an association can sponsor the relationship and provide a secure link to the user's personalized information."

"[0170] For example, suppose the user has purchased a Ford Escort automobile. Since the auto manufacturer would like to keep up to date on the car's maintenance, Ford can sponsor the user purchaser's membership in the RTSN and can provide a secure link to real-time information that is specifically personalized for the car"

Nowhere in these or other portions of the reference is there any hint or suggestion of Bolnick's retrieving contacts from different contact lists for the sake of comparing the contacts culled from the separate contact lists. Instead, throughout the reference, the focus is exclusively on providing different users secure access to the same set of information.

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second retrieving a plurality of contacts from an exposed, remotely accessible contact list associated with one of said first retrieved contacts;

second comparing said second retrieved contacts to said locally stored contacts

It follows that, whereas Bolnick fails to even hint at a first retrieving of contacts from a contact list for the sake of comparing them with contacts culled from yet a different list, Bolnick likewise fails to address a second retrieving and comparing. Accordingly, Bolnick also fails to teach or suggest either a second retrieving or a second comparing as recited in Claim 1.

first identifying common contacts among said first compared contacts;

second identifying common contacts among said second compared contacts

It is acknowledged at Page 3 of the Office Action that Bolnick fails to disclose either a first or second identifying step as recited in Claim 1. It is asserted, however, that this feature is to be found in Harari. Paragraphs 0031-0033 and 0043-0046 are cited in support of the contention.

Harari is explicitly directed to an address server system that provides automatic updates of user contact information by way of address client interactions. (Para. 0006; Abstract) The process of automatic updating is performed by "an address client requesting contact information for a user using the address client from [a] server, and the server providing the contact information." (Para. 0031.) The contact information includes "a list of all persons on the user's contact list" as well as "an indication of status of the contacts." Upon receipt of the contact information from the server, the client is able to update user information and change the status of a contact. The status is indicated by the state of a "distribute flag." (Para. 0032) The contact list is updated according to the status indicated by the flag. (Para. 0033.) According to one embodiment of Harari, an address contact information unit initiates a database query to locate and retrieve the most recent address contact information associated with the address client stored in the database. (Para's. 0043-46.)

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The explicit description of Harari throughout the reference is of a method of updating of individual repositories of stored information, not the comparison of contacts culled from separate lists of contacts. The updating performed by Harari is explicitly described as being based on status indicated by "distribute" and "retrieve flag[s]," not on the basis of an ascertained commonality of members of different sets of contact lists as in Claim 1:

"[0033] . . . If [a] contact has a distribute flag set to distribute for the user, and the user has set the retrieve flag to retrieve the contact's information, the address server determines if the update time of the associated information for the contact . . . is of a more recent date than the associated information in the user's data."

"[0043] The address contact information unit, upon receipt of the request from the address client, retrieves the most recent address contact information list associated with the address client that is stored, and transmits the list to the address client."

Accordingly, with Harari, a client merely retrieves the most current contact information. Harari is devoid of any suggestion of identifying common contacts among separate contacts culled from different list of contacts, irrespective of whether such contacts are new. As explicitly described, Harari is dependent on respective users' setting different flags in order to indicate the updating of contact information. There is no teaching or suggestion of an affirmative ascertainment of commonality among different contacts from separate contact lists.

At most, Harari merely adds detail to a process of updating of a single repository of contact information. It does not teach or suggest a first, let alone a first and a second, identifying of common contacts culled from separate contact lists as recited in Claim 1.

More fundamentally, since Bolnick fails to teach or suggest a first or second comparing of contact lists, there is no identification that can be made by Harari based on commonality ascertained through comparison. Accordingly, even when combined, Bolnick and Harari fail to teach or suggest Applicants' invention. Nothing in the common sharing of information hints at

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or suggests retrieving contacts from distinct contact lists and comparing the different contacts. The sharing of commonly accessible information, even if updatable, is simply not Applicants' invention, nor does it suggest Applicants' invention.

generating and storing a common contacts list, the common contacts list defining yet another distinct set and containing said identified common contacts

It is acknowledged at Page 4 of the Office Action that the combination of Bolnick and Harari fails to disclose generating and storing a common contacts list. This feature, it is asserted, is to be found in Bloebaum. Paragraphs 0032-0034 and 0037-0039 are cited in support of the assertion.

Bloebaum is directed to methods of sharing data among network-linked mobile communication devices based on the devices' acting as both clients and servers. (Para's. 0007-0010; Abstract.) The shared information in Bloebaum is GPS-related information, such as the GPS satellite ephemeris and the approximate time, as well as other, application specific data.

Bloebaum does not address the generating and storing of a list containing common contacts culled from different contact lists associated with different users, as recited in Claim 1. At most Bloebaum permits the compiling by a single mobile phone of GPS-related and other data obtained from other network-linked mobile phones:

"[0029] . . . a cell phone may compile the information that it needs from multiple sources in the group. Hence, the cell phone can put together data about different GPS satellites from multiple group members. The cell phone may need to sort the compiled data based on some criterion such as age of the assistance data. In another aspect of this invention, cell phones may exchange types of data other than GPS position-aiding type data. Exchanges of information such as phone numbers and e-mail addresses between phones may take place. Such exchanges may be generated, for example, by a high-level requirement by a user for synchronization between the databases of multiple phones used by the user."

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Accordingly, Bloebaum only speaks to the compilation, sorting, and exchange of data from different sources. Even the compilation, exchange, and sorting of different data, however, lacks any suggestion as to the generation of a new set of data based on an ascertained commonality among different members of different sets. With Bloebaum, a mobile phone can access information from another mobile phone, and add that information to its own set of information. For example, if a user wants to add or update GPS-related information or a phone number, Bloebaum provides a means of common access whereby the desired information can be obtained from another network-connected mobile phone. This, however, does not involve comparing different GPS-related information or different phone numbers. There is no selection based on a commonality between different data or phone listings. Accordingly, there is no selection determined by a comparison to ascertain commonality. Accordingly, there can be no generation or storage with Bloebaum of a distinct set containing contacts common to two separate contact lists, as recited in Claim 1.

The combination of Bolnick, Harari, and Bloebaum does not yield Applicants' invention, nor can the combination effect the processes of Applicants' invention. Bolnick provides secure access to information shared among multiple "associates." The adding of Harari merely provides a mechanism for updating the shared information. Further combining Bloebaum with Bolnick and Harari merely provides a mechanism whereby information can be shared in a network setting. The combination, however, fails to teach or suggest the features recited in Claim 1.

With Bolnick, each user supplies updates to the shared information (i.e., "pushed information). With Harari, users must set flags for information that is to be updated. With Harari, users must query other users to acquire new or updated information. No mechanism is provided for retrieving contacts from one contact list, comparing the contacts with those of another list, and identifying common contacts in order to generate yet another distinct set containing the contacts identified as being common to one another.

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Applicants respectfully assert, therefore, that the asserted combination of Bolnick, Harari, and Bloebaum fails to teach or suggest the recited features of Claim 1. Claims 2 and 3 depend from Claim 1, reciting yet additional features, and thus are likewise not rendered obvious by the prior art. Claims 12-14 are similar to Claims 1-3, and the same arguments apply with equal force to these claims. Accordingly, Claims 12-14 are also not rendered obvious by the prior art. Applicants thus respectfully request that the rejections of Claims 1-3 and 12-14 be withdrawn.

II. Claims 4 And 5, 15 And 16 Define Over Bolnick, Harari And Bloebaum

Claim 4 is directed to a method of generating a list of common contacts. The includes exchanging at least two contact lists over a physical communications link, each contact list defining a distinct set different from the other and corresponding to a different user; comparing contacts in the exchanged contact lists to identify matching contacts; and, generating and storing a contact list containing matched contacts that defines yet another distinct set.

The combination of Bolnick, Harari, and Bloebaum is also asserted against this claim. Each of the steps is here examined individually in the order and grouping that they are addressed in the Office Action.

generating and storing a contact list defining yet another distinct set and containing said matched contacts

At page 6 of the Office Action, it is asserted that Bolnick discloses a method of generating a list of common contacts. Paragraphs 0115-0118 of Bolnick are asserted in support of the assertion.

Bolnick does not teach or suggest generating any list, common or otherwise. Instead, the cited passage refers to a Real-Time-Social-NetworkTM that is intended to provide businesses, organizations, families and individuals with certain networking advantages. Nowhere is there any hint, however, that the advantages stem from the generation of a list of common contacts. In the cited passage, as throughout, the reference describes not the generating of a distinct set of

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information, but instead the providing of common access to a single source of information shared by related members or associates:

"[0117] Organizations [through the Real-Time-Social-Network™] can be able to create a more cohesive membership through the sharing of vital information like an up-to-the minute phone directory, calendar of events, and announcements."

The sharing of commonly accessible information, however, is far removed from the generation of a new, distinct set of information, as recited in Claim 4. The sharing of a common source of information has nothing to do with the generation of a new, distinct set of information. Indeed, given that Bolnick's stated objective is to provide secure access to existing information, it teaches away from the creation of new set of information: there is no motivation to create a new set if the existing information already exists at a source, and the only concern is to provide multiple users secure access to that existing information.

exchanging at least two contact lists over a physical communications link, wherein each contact list defines a distinct set different from the other and corresponds to a different user

It is acknowledged at Page 6 of the Office Action, that Bolnick does not disclose the exchange of two or more contact lists. It is asserted, however, that paragraphs 0006-0017 of Harari disclose such exchanges. The cited portions describe not an *exchange* of two or more contact lists, but rather the *contribution* of disparate contact information from different address clients to an address server. (Para. 0006.) This, however, does not teach or suggest any exchange of information, as recited in Claim 4.

Indeed, the objective Harari is counter to such an exchange. Such an exchange involves multiple transfers of data, whereas Harari is intended to provide a central source of information that can be shared among multiple members.

comparing contacts in said exchanged contact lists to identify matching contacts

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Harari is also cited for disclosing this feature, which is acknowledged at Page 6 of the Office Action to be lacking in Bolnick. Paragraphs 0031-0033 are cited as containing this disclosure.

As already noted, Harari throughout the reference is of a method of updating a individual repositories of stored information. Accordingly, Harari does not teach or suggest comparing contacts contained in exchanged contact lists. Moreover, absent such exchange, it is impossible for Harari to identify matching contacts based on such an exchange. The updating performed by Harari is based on the "distribute" and "retrieve flag[s]" that indicate status. But flag-designated status suggests nothing regarding identifying matching contacts by comparing exchanged contact lists, as recited in Claim 4.

Bloebaum is cited at Page 7 as disclosing that the exchanged contact lists and the list generated on the basis of matching contacts can each be different sets. As already noted, however, Bloebaum is directed to methods of sharing data among network-linked mobile communication devices where each device' acts as both a client and a server. (Para's. 0007-0010; Abstract.) Bloebaum does not address generating and storing a distinct set based on matching elements contained in other sets.

It follows that the asserted combination of Bolnick, Harari, and Bloebaum fail to teach or suggest every feature recited in Claim 4. Accordingly, Applicants respectfully request that the rejection of Claim 4 be withdrawn. Claim 5, which depends from Claim 4 while reciting additional features, is also not rendered obvious, and Applicants respectfully request withdrawal of the rejection of Claim 5 as well. Claims 15 and 16 are similar to Claims 4 and 5, and the arguments advanced with respect to the latter apply equally to the former. Accordingly, Applicants also respectfully request the withdrawal of the rejections of Claims 15 and 16.

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III. Claims 6 And 17 Define Over Bolnick, Harari And Bloebaum

Claim 6 is directed to a method of generating a list of common contacts. The method includes accessing a contact list defining a set being stored in a remotely accessible database of contacts; comparing contacts in the contact list with contacts in a stored database of contacts defining another distinct set, the contact list and the contacts in the stored database of contacts each corresponding to a different user; producing matching contacts as a result of the comparing; and providing a visual hyperlink for each matching contact produced by the comparing step.

The combination of Bolnick, Harari, and Bloebaum is asserted against this claim as well. The portions of the references cited in support of the rejection have already been addressed and need not be repeated in detail. Regardless of whether Bolnick provides a visual hyperlink, Bolnick fails to teach or suggest generating a list of common contacts. Instead, as already observed, Bolnick is intended to provide common access to a single source of information, not the generation of new information, let alone the generation of a contact list as recited in Claim 6..

Harari does not teach or suggest comparing contacts contained in separate contact lists associated with different users. Instead, Harari is exclusively directed to updating a single repository of stored information. Accordingly, Harari does not teach or suggest comparing contacts contained in separate contact lists as recited in Claim 6.

Applicants respectfully maintain that the asserted combination fails to teach or suggest each feature of Claim 6. Accordingly, Applicants respectfully request that the rejection of Claim 6 be withdrawn. Claim 17 is similar, and the arguments in support of Claim 6 apply equally with respect to Claim 17. Applicants, therefore, respectfully request that the rejection of Claim 17 likewise be withdrawn.

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IV. Claim 7 Defines Over Bolnick, Harari And Bloebaum

Claim 7 is directed to a common contact identification system. The system includes at least two contact lists, each defining a distinct set comprising a plurality of contacts associated with a different user and having a publicly accessible interface through which contacts can be accessed remotely; a comparator for comparing contacts in each of the contact lists to identify matching contacts in each the contact lists; and, common contact list, resulting from the comparison, the common contact list defining yet another distinct set comprising contacts matched by said comparator.

The combination of Bolnick, Harari, and Bloebaum is cited against this claim as well. The asserted combination, however, fails to teach or suggest each of the features recited in Claim 7. As shown above, none of the references teach or suggest, for example, comparing contacts culled from separate contact lists in order to identify matching contacts.

More particularly, the personal digital assistant (PDA) in FIGS. 7 and 9, as well as the text portions of Bolnick cited at Page 10 of the Office Action, do not suggest a comparator as recited in Claim 7. Instead, what is described in Bolnick is a "user interface" and "user home page:"

"[0238] FIG. 9 depicts a block diagram 900 illustrating an exemplary embodiment of a user interface illustrating an exemplary web-based version of a user's summary 'your home' home page . . . of the present invention. The view can include, e.g., new messages 906, a to-do list 904, and a calendar 902. FIG. 9 also illustrates interfaces easily ported to a personal digital assistant (PDA) 908, 910."

The cited portions merely reiterate that Bolnick is concerned not with identifying matches between different contacts culled from different contact lists, but rather with the secure sharing of updatable information with various "associates." Nothing in Bolnick suggests or even hints at

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a comparator capable of comparing contacts in different contact lists to identify matching contacts in the contact lists.

Accordingly, Applicants respectfully maintain that the cited art fails to render Claim 7 obvious. Applicants, therefore, respectfully request that the rejection of Claim 7 be withdrawn.

CONCLUSION

The Applicants believe that this application is in full condition for allowance, which action is respectfully requested. The Applicants invite the Examiner to call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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